

REMARKS

This paper is submitted in response to the non-final Office Action dated February 18, 2010 (the “Final Office Action”).

Claims 1-5, 7-12, 14-19, 21-33, 35-36, and 40-45 were previously pending in the application.

Claims 1-5, 7-12, 14-19, 21-33, 35-36, and 40-41 stand rejected.

The amendments add no new matter. Support for the amendments may be found throughout Applicant’s Specification and Drawings as originally filed, for example in ¶¶10-11, 32, 36, 39, 45, 62, and 73-74. While not conceding that the cited reference(s) qualify as prior art, but instead to expedite prosecution, Applicant has chosen to respond as follows. Applicant reserves the right to establish that the cited reference(s), or other references cited thus far or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed. Applicant respectfully submits that the pending claims are allowable in view of the following remarks and the above amendments, and respectfully requests reconsideration of the pending rejections.

Rejection of Claims under 35 U.S.C. § 103(a)

Claims 1-5, 7-12, 14-19, 21-33, 35-36, and 40-45 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over U.S. Patent No. 6,587,126 issued to Wakai, et al. (“**Wakai**”) in view of U.S. Patent No. 6,421,733 issued to Tso, et al. (“**Tso**”), U.S. Patent No. 7,167,919 issued to Iwamoto, et al. (“**Iwamoto**”), and U.S. Patent Publication No. 2004/0030693 by Toda (“**Toda**”). Applicant respectfully submits that the claims are allowable because a person having ordinary skill in the art would not make the proposed combination of references, and also because even if combined, the cited passages of the references would fail to disclose each limitation of Applicant’s claims.

Applicant's claim 1 recites that "**each of the plurality of devices is configured to provide a corresponding service,**" and that "**at least two devices among the plurality of devices are configured to provide the requested service.**" At least these limitations are absent from the cited passages of Wakai, Tso, Iwamoto, and Toda, whether taken individually or in combination.

With regard to these limitations, the Final Office Action presents two different arguments, citing different features of Toda. The two arguments are inconsistent with each other. More importantly, neither of these two arguments in the Final Office Action is capable of supporting the rejection of claim 1.

As a first argument, the Final Office Action proposes that Toda's printer element 31 and scanner element 32 each provide a "service of printing." *See* Final Office Action, p. 22. This is plainly incorrect. The cited passages of Toda do not teach that scanner element 32 should be understood to provide a service of printing. Toda's scanner element 32 is described as a scanner, not as a printer. This distinction is made all the more unambiguous since Toda plainly teaches a printer element, which is described as being used for printing. A person having ordinary skill in the art would not confuse Toda's printer element 31 and scanner element 32 as providing the same service of printing, as proposed in the Final Office Action. The rejection of claim 1 rests on this incorrect characterization of Toda's scanner element 32, and is therefore in error.

As a second argument, the Final Office Action proposes that Toda's printer element 31 and scanner element 32 each provide a "copy service." *See* Final Office Action, p. 3. Applicant respectfully disagrees. Here the Final Office Action considers, in a manner that is inconsistent with the first argument discussed above, a copy service instead of a printing service. But printer element 31 is not described as being capable of providing a copy service.

A printer is not a copier. A person having ordinary skill in the art would readily understand that Toda's printer element 31 could be used in conjunction with another device or element (e.g., a scanner) to support a copy service—but is incapable on its own to "provide" a copy service.

Similarly, Toda's scanner element 32 is also not capable to "provide" a copy service. A scanner is also not a copier. Accordingly, these cited features—Toda's printer element 31 and scanner element 32—are not elements that are each configured to "provide" a copy service.

In making the argument regarding a copy service, the Final Office Action appears to take the position that the word “provide” could be understood to mean “provide at least a portion of.” Thus, the Final Office Action appears to read applicant’s claim as reciting that “at least two devices among the plurality of devices are configured to provide” *at least a portion of* “the requested service.” Accordingly, the Final Office Action argues, in effect, that Toda’s printer element 31 provides *a portion of* a copy service, and that Toda’s scanner element 32 similarly provides *a portion of* a “copy service.”

But this argument is based on a reading of Applicant’s claim 1 that is inconsistent with the actual wording of the claim. By turning to these two different elements of Toda, the Final Office Action appears to recognize that neither Toda’s printer element 31 nor Toda’s scanner element 32 is capable of providing a copy function. Thus, under the plain reading of claim 1, the cited printer element 31 and scanner element 32 are not “at least two devices among the plurality of devices” that “are configured to provide the requested service.”

In addition, claim 1 recites that “each” of the plurality of devices is “configured to provide a corresponding service.” Thus, claim 1 makes clear that each of the plurality of devices has a corresponding service—and is not merely used only for a *portion of* a service, as would be required for the Final Office Action’s second argument to hold water.

At least for these reasons, the cited passages of Toda fail to disclose that “each of the plurality of devices is configured to provide a corresponding service,” and that “at least two devices among the plurality of devices are configured to provide the requested service,” as recited in Applicant’s independent claim 1.

A rejection under § 103(a) may establish, among others, that “all the claimed elements were known in the prior art.” *See MPEP § 2143.02* (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007)). The pending rejection attempts to meet this standard, but falls short with regard to amended claim 1 because of above-noted failings of the Wakai-Tso-Iwamoto-Toda combination. At least for this reason, independent claim 1 and all claims dependent claims thereon are allowable under § 103(a). At least for similar reasons, independent claims 9, 16, and 23 and all claims dependent thereon are also allowable under § 103(a).

Dependent claim 43.

The cited printer element 31 and scanner element 32 have additional shortcomings in view of the limitations of claim 43, which depends on claim 1. Claim 43 additionally recites that the at least two devices include the first device and a second device, and that “**the first device is produced by a first vendor,**” “**the second device is produced by a second vendor,**” and “**the second vendor is distinct from the first vendor.**”

As discussed above, the Final Office Action equates Toda’s printer element 31 and scanner element 32 with the at least two devices. *See* Final Office Action, p. 3. But Toda fails to disclose that these elements are produced by different vendors. Indeed, Toda teaches the opposite: that these elements are combined in a single multifunction peripheral apparatus (MFP) 2.

The cited passages thus additionally fail to disclose that the second vendor “is distinct from” the first vendor, as recited in claim 43. Accordingly, claim 43 is additionally patentable under § 103(a).

Amended claim 42.

In addition, the cited printer element 31 and scanner element 32 have further shortcomings in view of the limitations of amended claim 42, which depends on claim 1.

Claim 42 recites that the first device is configured to provide the requested service, and that the second device is configured to provide the requested service. As recited in claim 1, the first device is configured to provide the requested service in response to receiving the second request. However, “**the second device is configured to receive requests only in a format that is incompatible with the request format defined in the second language.**”

As discussed above, the Final Office Action equates Toda’s printer element 31 and scanner element 32 with the at least two devices. *See* Final Office Action, p. 3. But Toda does not disclose that these elements have any contrasting language qualities. In particular, Toda does not disclose that printer element 31 (or scanner element 32) can provide a copy service in response to a request while scanner element 32 (or printer element 31) is incompatible with a format of that request.

The cited passages thus additionally fail to disclose that the second device is configured to receive requests only in a format that is incompatible with the request format defined in the second language, as recited in amended claim 42. Accordingly, claim 42 is additionally patentable under § 103(a).

Amended claim 45.

Moreover, the cited printer element 31 and scanner element 32 have further shortcomings in view of the limitations of amended claim 45, which depends on claims 1 and 43.

Claim 45 additionally recites that the first device is produced by a first vendor (*see* intermediate claim 43), and that the second request conforms to requests generated using a dynamic link library (DLL) provided by the first vendor. However, “**the second device is incompatible with requests generated using the DLL provided by the first vendor.”**

As discussed above, the Final Office Action equates Toda’s printer element 31 and scanner element 32 with the at least two devices. *See* Final Office Action, p. 3. But Toda does not disclose that these elements have any DLL incompatibilities. In particular, Toda does not disclose that printer element 31 conforms to requests generated using a particular DLL, while scanner element 32 is incompatible with such requests (or vice-versa).

The cited passages thus additionally fail to disclose that the second device is incompatible with requests generated using the DLL provided by the first vendor, as recited in amended claim 45. Accordingly, claim 45 is additionally patentable under § 103(a).

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance and a notice to that effect is solicited.

Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5097.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. The undersigned hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. §§ 1.16 or 1.17, be charged to deposit account no. 502306.

I hereby certify that this correspondence is being submitted to the U.S. Patent and Trademark Office in accordance with 37 C.F.R. § 1.8 on April 19, 2010 (CT) by being (a) transmitted via the USPTO's electronic filing system; or (b) transmitted by facsimile to 571-273-8300; or (c) deposited with the U.S. Postal Service as First Class Mail in an envelope with sufficient postage addressed to: Mail Stop AE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

/ Cyrus F. Bharucha /
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April 19, 2010
Date

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